

IN THE CLAIMS

Please amend claims 18, 20, 29 and 30 as shown on the APPENDIX OF MARKED-UP VERSION OF CLAIMS. A clean version of amended claims 18, 20, 29 and 30 is shown on the APPENDIX OF CLEAN VERSION OF CLAIMS.

Please add new claims 35-37 as shown on the APPENDIX OF CLEAN CLAIMS.

REMARKS

1. Rejection of claim 20 under 35 U.S.C. § 112, second paragraph

Claim 20 stands rejected under 35 U.S.C. § 112, second paragraph for failing to distinctly define the present invention. Specifically, claim 20 was amended to recite that the composition includes acrylates or a mixture of polymers or copolymers having a substantially high acrylate content in comparison to other ingredients in said composition. Applicants submit that amended claim 20 overcomes the rejection by providing a relationship in which the amount of acrylate content can be compared. Accordingly, withdrawal of the rejection is requested.

2. Amendments to claims 18, 29 and 30

Applicants submit amended claims 18, 29 and 30 which were amended to more clearly recite the subject matter contained therein. Such amendments were not made for reasons of patentability and instead were merely made as a matter of claiming style. It is also submitted that such amendments do not narrow the scope of the claims. It is respectfully submitted that no new issues requiring further detailed consideration or search have been presented by the proposed amendments and that entry of the proposed amendment is appropriate under 37 C.F.R. 1.116.

Entry of the proposed amendment for the purpose of appeal is respectfully submitted in the event that the Examiner elects to maintain the final rejection of the claims.

3. Rejection of claims 18-19, 21-23 and 26-34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,388,862 (Edwards)

Claims 18-19, 21-23 and 26-34 stand rejected as being unpatentable over Edwards. Applicants traverse this rejection. For the reasons put forth below, Applicants respectfully assert that claims 18, 29 and 30 are presently patentable over Edwards. Claims 19, 21-23 and 26-34, which directly or indirectly depend from claims 18 or 30, are also patentable on the basis of their dependency from claims 18 or 30 and their individual structural elements.

First, as stated in response to the first Office Action, Applicants maintain that Edwards fails to disclose or suggest a security paper having a surface coating comprising a non-polyurethane composition containing a binder and lacking a filler substance. While it is true that the security elements of the security article of Edwards have a surface coating, Edwards fails to substantially disclose the composition of such coatings and therefore does not disclose the surface coating composition of the present invention.

In the statement of reasons of the Final Office Action, there is no indication or reference provided which demonstrates that Edwards teaches the surface coating composition of the present invention. In fact, it appears that treatment of the surface coating composition of the present invention is completely omitted in the rejection as evidenced by the failure in the Response to Arguments in the Final Office Action to even address the arguments that were made in response to the first Office Action.

Applicants respectfully submit that nowhere in Edwards is there a teaching of providing a security paper with a surface coating comprising a non-polyurethane composition containing a binder and lacking a filler substance.

Applicants would like to point out, as discussed in the remarks to the first Office Action, that the surface coating composition yields advantages over the prior art references, including Edwards. The [coating of the present invention is processed so as to protect the security paper and therefore extend its circulation life.] Essential to the properties of the coating is that the coating does not alter the printability, sound and color of the present invention. Furthermore, it has been found that a[binder composition without fillers has superior wetting properties and forms a complete surface film over the fibers of a security paper.]

Surface coatings based on polyurethane are not satisfactory for use in regards to printing properties and surface hardness of security articles. Furthermore, coatings based on polyurethane require large amounts of solvent. In the present invention, the addition of polyurethane was avoided so that the composition of the coating excluded both fillers and polyurethane. The composition of the present invention provides for improved printed properties and contains substantially less solvent so that its processing has a lower environmental impact.

Applicants submit that it would not be obvious to one of ordinary skill in the art in view of Edwards nor any of the other cited references to apply a surface coating composition to a security paper that [is a non-polyurethane composition that contains a binder and lacks a filler substance.] To extent that the Examiner is relying upon "well known art" that it would be obvious to apply the aforesaid surface coating of the present invention on a security paper, Applicants respectfully request the Examiner to identify such well known art.

Second, Applicants respectfully traverse the Examiner's assertion that the security thread in Edwards is the equivalent of the security paper of the present invention. Specifically, in response to Applicants' previous arguments regarding the fact that the security thread in Edwards cannot be confused with the security paper of the present invention, the Examiner indicated that paper is essentially a woven sheet, composed of threads.

Applicants would like to point out that the “security thread” in Edwards is not a fiber or thread that would be used to weave a fabric or used as pulp to form paper. Instead, “security thread” is a term of art used in the art of security articles and is also referred to as a security element. In the words of Edwards, a security thread or element may be made from transparent film with a continuous reflective layer and which is further vacuum deposited on a polyester film (Edwards, col. 1, lines 12-25). Examples of the reflective layer include a thin sheet of metal, such as aluminum (col. 2, lines 37-50) Edwards further devotes the remainder of the patent to describing a new “security thread” or security element in the aforesaid context.

It follows that it would be absurd indeed to weave, in the words of the Office Action, paper with the security thread described in Edwards. Not only would the security thread in Edwards likely fail to weave or be successful to be used as pulp to form paper, but it would be impractical. Accordingly, Applicants submit that when used in its proper context, security threads cannot be woven into a security paper and therefore cannot be considered an equivalent to the security paper of the present invention.

Applicants would like to remind the Examiner that prior art must be considered in its entirety and it is quite clear that Edwards does not disclose or teach a security paper having a surface coating of the composition of the present invention, it follows that there are no equivalent teachings in Edwards that could be equated as the security paper and surface coating of the present invention.

Lastly, Applicants traverse the Examiner’s assertion that producing the security paper with the specific surface coating composition of the present invention would be obvious to one of ordinary skill in the art. The Examiner has cited no art teaching the method of producing the security paper of the present invention. To the extent that the Examiner is relying on “well known art”, Applicants respectfully request the Examiner to identify such well known art pursuant to MPEP 2144.03. Applicants are unable to assess the teachings of such art until it is identified.

Since Edwards fails to disclose or suggest a security paper with a surface coating disposed on at least one surface of the security paper and lacking a filler substance and polyurethane, it is respectfully submitted that Edwards does not disclose or suggest the basic claimed invention of the present invention. Accordingly, removal of this rejection is requested.

4. Rejection of claim 24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,388,862 (Edwards) and further in view of U.S. Patent 5,161,829 (Detrick et al.)

Claim 24 stands rejected as being unpatentable over Edwards in view of Detrick et al. Applicants traverse this rejection. Detrick et al. fail to make up for the aforementioned shortcomings of Edwards, namely Detrick et al. do not disclose or suggest a security paper having a coating having a surface coating disposed on at least one surface of the security paper wherein the coating comprises a non-polyurethane composition containing a binder lacking a filler substance.

Accordingly, Edwards and Detrick et al., whether considered collectively or independently, fail to disclose or suggest the basic claimed invention of claim 18. Claim 24, which is directly dependent from claim 18, is therefore patentable based on its dependency from claim 18. Accordingly, withdrawal of the rejection is respectfully requested.

5. Rejection of claims 20 and 25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,388,862 (Edwards) and further in view of U.S. Patent 6,023,239 (Howland et al.)

Claims 20 and 25 stand rejected as being unpatentable over Edwards in view of Howland et al. Applicants traverse this rejection. Howland et al. fail to make up for the shortcomings of Edwards, namely Howland et al. do not disclose or suggest a security paper having a coating having a surface coating disposed on at least one surface of the

security paper wherein the coating comprises a non-polyurethane composition containing a binder lacking a filler substance.

Accordingly, Edwards and Howland et al., whether considered collectively or independently, fail to disclose or suggest the basic claimed invention of 18. Claims 20 and 25, directly dependent from claim 18, are therefore patentable based on its dependency from claim 18. Accordingly, withdrawal of the rejection is respectfully requested.

6. New Claims

Applicants include herewith new claims 35-37 which depend from claims 18, 29 and 30, respectively, and recite that the at least one surface coating is applied to the entirety of the at least one surface. Support for these claims is implicit in the claims as originally filed and it is not believed that these claims raise new issues requiring further detailed consideration or search. Acceptance of these claims is respectfully requested.

Entry of the proposed amendment for the purpose of appeal is respectfully submitted in the event that the Examiner elects to maintain the final rejection of the claims.

7. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that claims 18-37 be allowed and the application be passed to issue.

Application No.: 09/719,559
Art Unit: 1774
Examiner: L. Ferguson

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicants' Attorney, the Examiner is invited to contact the undersigned at the numbers shown below.

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APPENDIX OF MARKED-UP VERSION OF CLAIMS

18 (Amended). A security paper comprising:

a surface coating disposed on at least one surface of said security paper;

wherein said coating comprises a non-polyurethane composition containing a binder[,] and [lacks] lacking a filler substance[and polyurethane].

20 (Amended). The security paper according to claim 18, wherein said composition includes acrylates or a mixture of polymers or copolymers having a ^{mol wt} substantially high acrylate content [as a binder] in comparison to other ingredients ¹¹⁰⁷² in said composition.

29 (Amended). A document of value comprising a security paper having a surface coating disposed on at least one surface of said security paper, said coating including a non-polyurethane composition containing a binder, and lacking a filler substance[and polyurethane], wherein said security paper further includes a print disposed over said surface coating and covered by an outer coating including a laquer layer.

30 (Amended). A method for producing a security paper [according to claim 18], said method comprising the steps of:

producing a paper layer in a paper machine; and

applying a coating to at least a part of a surface of said paper;

wherein said coating comprises a non-polyurethane composition containing a binder[, said composition] and lacking a filler substance[and polyurethane].

35 (New Claim). The security paper according to claim 18, wherein said surface coating extends along the entirety of the at least one surface.

Application No.: 09/719,559
Art Unit: 1774
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36 (New Claim). The security paper according to claim 29, wherein said surface coating extends along the entirety of the at least one surface.

37 (New Claim). The method for producing a security paper according to claim 30, wherein the coating is applied to the entire surface of the paper.

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